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10/561,087	12/16/2005	Hiroshi Yahata	92478-8300	2444

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EXAMINER

WENDMAGEGN, GIRUMSEW

ART UNIT	PAPER NUMBER
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2621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,087	Applicant(s) YAHATA ET AL.	
	Examiner Girumsew Wendmagegn	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-9 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-9 and 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/16/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim1-3, 6 and 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim1 is drawn to a recording medium having recorded a digital stream. It is a nonfunctional descriptive material and it is non-statutory. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement.

Claim 2-3 and 6 is also reject for the reason that it depends on claim1.

Claim 14 is drawn to a "program" *per se* as recited in the preamble and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other

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claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1-3, 6-9, and 12-15 is rejected under 35 U.S.C. 102(e) as being anticipated by Okada et al (Pub. No. WO 2004/098193).

Regarding claim1, 13, Okada anticipates a recording medium used for storing data, comprising: a digital stream generated by multiplexing a video stream and a graphics stream, the graphic stream is a sequence of a plurality of packets which include a packet containing control information (see page3 line11-22); and the control information indicates that graphic data contained in a preceding packet in the sequence is to be displayed at a predetermined time in a state of being overlaid on the video stream (see page5 paragraph 0092).

Regarding claim2, Okada anticipates the recording medium of claim1, wherein: each of the plurality of packets belongs to any of a plurality of display sets which are each used for reproducing a graphics display (see figure 31 EPOCH Start, Acquisition Point and Normal Case); the graphics data and the control information belong to different display sets (see figure 31 ODS belongs to Epoch or Acquisition control information belongs to Normal case).

Regarding claim3, Okada anticipates the recording medium of claim 2, wherein the display sets further comprise: a Epoch Start DS having information necessary for displaying a next screen composition and is provided at the start of memory management on a reproduction time axis (see page13 line 22-27); an Acquisition Point DS having information necessary for displaying a next screen composition (see page13 line28-page40 line 1-6); and a Normal Case DS having difference information from a

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previous screen composition (see page14 line 18-28); wherein the Epoch Start DS is provided at the start of a memory management on a reproduction time axis and the Acquisition Point DS and the Normal Case DS are provided at a point other than the start of the memory management; and the graphic data belongs either to the Epoch Start DS or the Acquisition Point DS, and the control information belongs to the Normal Case DS (see figure 31 ODS belongs to Epoch or Acquisition control information belongs to Normal case).

Regarding claim6, Okada anticipates the recording medium of claim 18, wherein; the Epoch Start DS includes window information for specifying an area of displaying the graphic data (see figure9 Epoch Start (DS)); the window information specifies a position, a height, and a width of a window on a screen, the window being an area in which the graphics data is to be rendered when overlaying the graphics data on the video stream (see figure8A Window Definition Segment); and the control information indicates that the graphics data is to be positioned within the window (see figure8B window_informations).

Regarding claim7, 14 and 15, A reproduction apparatus for reproducing a digital stream generated by multiplexing a video stream and a graphics stream, comprising: a video decoder operable to decode the video stream to generate a moving picture (see figure26 video decoder); and a graphics decoder operable to decode the graphics stream to generate graphics, wherein upon reading control information in the graphics

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stream, the graphics decoder transfers graphics which has been generated by decoding graphics data that precedes the control information in the graphics stream to a plane memory, based on the control information(see figure 26 graphics decoder and page44 line 4-6).

Regarding claim8, the reproduction apparatus of claim 7, wherein: the graphics stream includes a plurality of display sets each of which is used for producing a graphics display (see page13 line 21); and upon reading the display set to which the graphics data belongs, the graphics decoder decodes the graphics data to generate the graphics and stores the generated graphics to an object buffer (see page45 line 7-10).

Regarding claim9, Okada anticipates the reproduction apparatus of claim 8, wherein the plane memory is memory for overlaying the graphics and the video, the display sets comprise: a Epoch Start DS having information necessary for displaying a next screen composition and is provided at the start of memory management on a reproduction time axis (see page13 line 22-27); an Acquisition Point DS having information necessary for displaying a next screen composition (see page13 line28-page40 line 1-6); and a Normal Case DS having difference information from a previous screen composition (see page14 line 18-28); wherein the Epoch Start DS is provided at the start of a memory management on a reproduction time axis and the Acquisition Point DS and the Normal Case DS are provided at a point other than the start of the

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memory management; and the graphic data belongs either to the Epoch Start DS or the Acquisition Point DS, and the control information belongs to the Normal Case DS (see figure 31 ODS belongs to Epoch or Acquisition control information belongs to Normal case); and the reproduction apparatus continuously manage the object buffer and the plane memory from one Epoch Start DS and before the next immediate Epoch Start DS on the reproduction time axis (see page11 line 28-30 and page12 line 1-4).

Regarding claim12, Okada anticipates the reproduction apparatus of claim9, wherein: the Epoch Start DS includes window information for defining an area of displaying the graphic data (see figure9 EPOCH start (WDS)); the window information specifies a position, a height, and a width of a window on a screen, the window being an area in which the graphics data is to be rendered when overlaying the graphics data on the video stream (see figure8A Window definition segment); and the graphics decoder displays the graphics by clearing the window specified by the window information and writing the graphics into the window (see figure28).

The applied reference has a common inventor(s) with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Girumsew Wendmagegn whose telephone number is 571-270-1118. The examiner can normally be reached on 7:30-5:00, M-F, alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thai Tran
Supervisory Patent Examiner

Girumsew Wendmagegn